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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,195	08/28/2000	Stephen J. Whitney	0112690-004	7963

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EXAMINER

LAXTON, GARY L

ART UNIT

PAPER NUMBER

2838

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/649,195

Applicant(s)

WHITNEY, STEPHEN J.

Examiner

Gary L. Laxton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitations "the first, second and third terminals" in line 2. There is insufficient antecedent basis for these limitations in the claim.

Claim 21 recites the limitations "the first and second services" in line 5. There is insufficient antecedent basis for these limitations in the claim.

Claims 22-25 inherit the deficiencies of claim 21.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-10, 13, 15, 16, 20-24, 26, 27, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Curry.

Curry discloses an integral circuit protection device (210) providing overcurrent and overvoltage protection for a circuit (66) and configured to be connected to a circuit (42, 46, 60, 62) comprising an overcurrent protection portion (fuse 5A, figure 2) contained by a mounting member (212; also considered an atmospherically resistant encapsulant); an overvoltage protection portion (40, figure 1) contained by a mounting member (212; also considered an atmospherically resistant encapsulant); a plurality of terminals (42, 46) for connecting both portions of the device (210) to a circuit to be protected (66), wherein a part of the overvoltage protection portion serves as one of the plurality of terminals (42 or 46). Furthermore, as can be observed the fuse element (5) is in series with the load circuit and the voltage protection device (210) is in parallel and both are mounted on a circuit board (216). Still further, thermal portions (252) with temperature coefficients conduct heat away from overvoltage portion (col. 8 lines 60-

68). Even further, the circuit board (216) (substrate) comprises two sides wherein the terminals are on one side (figure 3); also the protection devices are provided on one side. Circuit board is also thermally conductive to a degree.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11, 12, and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curry in combination with Nabell et al.

Curry discloses the claimed subject matter with regards to claims 13 and 30 as stated above except for providing a second overcurrent and second overvoltage device connected in the circuit as claimed in the above mentioned claims.

Nabell et al teaches completely the claimed circuit structure of the instant application. As observed in figure 1 there is illustrated a circuit for protection of communication lines comprising two overcurrent portions (fuses 105 and 106) as well as three overvoltage protection portions (device 109) as claimed including the ground connection (110). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the protection circuit of Nabell et al in place of the protection circuit of Curry in order to provide an improved circuit design that meets UL requirements and provides effective sneak current protection.

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8. Claims 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curry in combination with Myuong et al.

Curry discloses the claimed subject matter with regards to claims 13 and 21 as stated above except for the circuit comprising a bond pad for a terminal to the protection device.

Myuong et al teach in Col. 10 lines 5-10 that it is known in the art to connect components by bonding them. Furthermore, circuit board is known to have traces and bonding pads for connecting components and ensuring an electrical conduction path is present. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a bond pad for making an electrical connection between a terminal and the protection device.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 14, 17, 18, 28 and 29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1-26 and 28-34 of copending Application No. 09/534,277. Although the conflicting claims are not identical, they are not patentably distinct from each other because in the above mentioned claims the applicant refers to a "mounting member" in the instant application as opposed to a "housing" as used in the conflicting application. The claimed phrases are interchangeable and not patentably distinct. Furthermore, the mounting member which comprises a tube with first and second terminals disposed on the outer surface was previously claimed in the conflicting application, however, as stated above the previous application recited a "housing" instead of a "mount member". This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

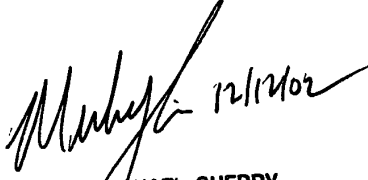
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,712,610 Takeichi et al disclose a protective device formed on a substrate; US 5,675,468 Chang discloses an apparatus for protecting equipment comprising a triac.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L. Laxton whose telephone number is (703) 305-7039.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Sherry can be reached on (703)308-1680. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


MICHAEL SHERRY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

GLL
December 10, 2002